

REMARKS

In the Examiner's Action, all of the claims to the elected specie were rejected both under the judicially created doctrine of obviousness type double patenting and under 35 U.S.C. § 102 based upon the Leysieffer et al. patent (hereafter, Leysieffer). Both of these rejections are inappropriate and should be withdrawn for the following reasons.

However, before addressing the merits of the rejections, it is pointed out that they are inconsistent with the Examiner's position that various embodiments of this application represent patentably distinct inventions. For example, the primary difference between the Fig. 9 and 10 embodiments is the presence of a flange which is engageable against a side of the wall of the auditory canal which faces skin of the auditory canal in the Fig. 9 embodiment that is lacking in the Fig. 10 embodiment (and is also lacking in the elected embodiment). However, such a flange is recited in claim 1 of the Leysieffer patent but is absent from claim 1 of the present application (see appended comparison). If such a feature represents a patentable distinction between embodiments of this application, how can its presence in the patent claims be ignored when evaluating the ability of the Leysieffer patent to teach the present invention. On the other hand, if such is not significant for purposes of the above mentioned rejections applied against the claims of this application, then the basis of the election requirement has been withdrawn by the Examiner and the relevant species combined. The same is true for the sealing lips 20, 22 of the elected embodiment which are recited in claims 2-8 of this application, but are lacking in the disclosure and claims of the Leysieffer patent as well as the other embodiments of this application. If claims 2-8 claim only an obvious variant of the claims of the Leysieffer patent which does not disclose such sealing lips and the use of such lips and the absence of a flange of the type noted above is the primary distinction of the elected embodiment, how can it be properly the subject of the election requirement made; on the other hand, if a significant distinction, how can it be anticipated or rendered obvious by a patent that has a flange but no sealing lips?

Thus, it is submitted that either the restriction requirement or the outstanding rejections must be withdrawn since they are mutually exclusive.

Turning now to the merits of the rejections, as already noted, significant features of the elected embodiment are totally lacking and unsuggested by anything disclosed or claimed in the Leysieffer patent. In this regard, it is submitted that the Examiner's assessment of the

nature and content of claim 1 of this application is erroneous. In particular, the Examiner's attention is directed to the italicized bolded portion of claim 1 of this application. This portion of the claims recites the fact that, in accordance with the present invention, the at least one elastic region of the cylindrical portion which is of increased diameter contacts "a wall of said bore" and that the elastic restoring forces act to fix the cylindrical portion by "friction." In contrast, the elastic flange 23 of the Leysiefer patent which the Examiner equates to this feature does *not* engage a wall of the bore, but rather is "engageable against a side of the wall of the auditory canal which faces skin of the auditory canal." Thus, the Leysiefer patent teaches that an entirely different surface is engaged from that specified in applicants' claims and one which would not render obvious the use of a resilient enlargement inside of the bore. Furthermore, the reason why one would not locate the flange of the Leysiefer patent within his bore is that, unlike the present invention which produces fixing by "friction," in the Leysiefer patent fixing of the fixation element is produced by clamping of the element between the resiliently deformable flange 23 and the rigid flanges 24, 25 with friction playing no role in the securement. This failure of the Leysiefer patent to teach or even suggest the present invention defined by claim 1 is reflected both in the disclosure and claims of that patent, and this failure becomes even more acute when consideration is given to the dependent claims, such as claims 2-8 which, as noted above, set forth that the "region of increased diameter is defined by at least one sealing member which is adapted to *sealingly contact the wall of the bore*," something not done by the flanges of the Leysiefer patent which are not sealing lips "adapted to fold in the direction of the side remote from the skin of the auditory canal" or "tapered towards the skin of the auditory canal," but instead fold and taper in the opposite direction.

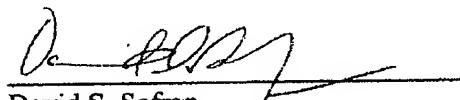
For all of these reasons, it is submitted that the claims of this application define subject matter that is neither an obvious variation of that which is claimed in the Leysiefer patent nor anticipated or rendered obvious by anything derivable from the disclosure of the Leysiefer patent. Therefore, withdrawal of the outstanding rejections is in order and is requested, along with allowance of this application in the absence of any new and more pertinent prior art being discovered.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which

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could be eliminated through discussions with applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,



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Comparison of Applicants' Claim 1 & Claim 1 of U.S. Patent 5,999,632

Applicants' Claim 1

1. A fixation element for an implantable microphone, wherein the fixation element comprises  
an essentially cylindrical portion adapted to be inserted into a bore which crosses a wall of the auditory canal of a user, said cylindrical portion, at least in an implanted state of the fixation element, surrounding an outer circumferential portion of a housing part of the microphone, which housing part is provided with a sound receiving member,

*wherein said cylindrical portion includes at least one elastic region of increased diameter, said elastic region contacting, in the implanted state of the fixation element, a wall of said bore and providing, by elastic restoring forces, for a friction which is sufficiently high to fix said cylindrical portion in at least one of the two axial directions of said bore.*

Claim 1 of U.S. Patent 5,999,632

1. Fixation element for an implantable microphone having

a cylindrical housing part provided with an acoustic membrane which is insertable into a hole which crosses a rear bony wall of the auditory canal of a user, said fixation element comprising

a sleeve which has a cylindrical sleeve part for surrounding the cylindrical housing part of the implantable microphone, in use, and

*which has projecting, elastic flange parts which are engageable against a side of the wall of the auditory canal which faces skin of the auditory canal.*